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DAO, THUY CHAN				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* KWASI ADDO ASARE, ATTILA BARTA,  
RICHARD D. HUDDLESTON and DANIEL E. JEMIOLO

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Appeal 2009-007451  
Application 10/726,192  
Technology Center 2100

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Before JAMES D. THOMAS, JOSEPH L. DIXON, and  
LANCE LEONARD BARRY, *Administrative Patent Judges*.

THOMAS, *Administrative Patent Judge*.

DECISION ON APPEAL<sup>1</sup>

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<sup>1</sup> The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the “MAIL DATE” (paper delivery mode) or the “NOTIFICATION DATE” (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

### STATEMENT OF THE CASE

This is an appeal under 35 U.S.C. § 134 (a) from the Examiner's final rejection of claims 1, 2, 4 through 7, 11, 12, and 14 through 17. We have jurisdiction under 35 U.S.C. § 6(b).

We vacate the art rejection before us made under 35 U.S.C. § 102 and institute a new ground of rejection within the provisions of 37 C.F.R. § 41.50(b).

### INVENTION

The present invention is a method, system and apparatus for hosting an environment abstraction. A method for hosting environment abstractions can include the step of enumerating each of a set of components in an application and identifying dependencies between each component in the set. A generic representation of the set of components can be organized into a hierarchical structure based upon the identified dependencies.

Consequently, a model encapsulating the hierarchical structure can be produced. Optionally, dependencies between target platform resources and the components in the set further can be identified and recorded in the model. Finally, the model can be stored in a repository for subsequent retrieval.

(Spec. 18, Abstract; figures 1 through 3)

### REPRESENTATIVE CLAIM

1. A hosting environment abstraction method comprising the steps of:  
enumerating each of a set of components in an application;

identifying dependencies between each component in said set;  
organizing a generic representation of said set of components into a hierarchical structure based upon said identified dependencies;  
producing a model encapsulating said hierarchical structure; and,  
storing said model in a repository for subsequent retrieval, wherein said identifying step comprises the step of inspecting each component in said set for data and method member references to other ones of said components in said set, said references indicating a dependency, and the components are application components, and the application comprises the set of components.

#### PRIOR ART AND EXAMINER'S REJECTION

The Examiner relies on the following reference as evidence of anticipation:

Grier	US 6,871,344 B2	Mar. 22, 2005 (Filing date: Apr. 24, 2001)
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All claims on appeal, claims 1, 2, 4 through 7, 11, 12, and 14 through 17, stand rejected under 35 U.S.C. § 102(b) has been anticipated by Grier.

#### ANALYSIS

We vacate the prior art rejection encompassing all claims on appeal because we conclude that all claims on appeal, claims 1 through 45, are “barred at the threshold by § 101.” *In re Comiskey*, 554 F.3d 967, 973 (Fed. Cir. 2009) (citing *Diamond v. Diehr*, 450 U.S. 175, 188 (1981)). Therefore, the following new ground of rejection is set forth in this Opinion within the provisions of 37 C.F.R. § 41.50(b).

NEW REJECTION UNDER 35 U.S.C. § 101

PRINCIPLES OF LAW

*Statutory Subject Matter*

The subject matter of claims permitted within 35 U.S.C. § 101 must be a machine, a manufacture, a process, or a composition of matter. Moreover, our reviewing court has stated that “[t]he four categories [of § 101] together describe the exclusive reach of patentable subject matter. If the claim covers material not found in any of the four statutory categories, that claim falls outside the plainly expressed scope of § 101 even if the subject matter is otherwise new and useful.” *In re Nuijten*, 500 F.3d 1346, 1354 (Fed. Cir. 2007); accord *In re Ferguson*, 558 F.3d 1359 (Fed. Cir. 2009). This latter case held that claims directed to a “paradigm” are nonstatutory under 35 U.S.C. § 101 as representing an abstract idea. Thus, a “signal” cannot be patentable subject matter because it is not within any of the four categories. *In re Nuijten*, 500 F.3d at 1357. Laws of nature, abstract ideas, and natural phenomena are excluded from patent protection. *Diamond v. Diehr*, 450 U.S. at 185. A claim that recites no more than software, logic or a data structure (i.e., an abstraction) does not fall within any statutory category. *In re Warmerdam*, 33 F.3d 1354, 1361 (Fed. Cir. 1994). Significantly, “[a]bstract software code is an idea without physical embodiment.” *Microsoft Corp. v. AT&T Corp.*, 550 U.S. 437, 449 (2007). The unpatentability of abstract ideas was reaffirmed by the U.S. Supreme Court in *Bilski v. Kappos*, 130 S. Ct. 3218 (2010).

With this background in mind, all claims on appeal, claims 1, 2, 4 through 7, 11, 12, and 14 through 17, are rejected under 35 U.S.C. § 101 as being directed to nonstatutory subject matter.

Consistent with our earlier -- noted invention statement taken from Appellants' Abstract of the disclosure, the disclosed and claimed invention is directed to software per se, abstract ideas, abstract/generic concepts and methodologies and the like, abstract models, including various data structures and named characterizations of data, and abstract intellectual processes associated with them within the claims on appeal.

More specifically, independent claim 1 recites software components in software application programs, logical hierarchical relationships/dependencies between/among each software component, logical "sets" of software components, an abstract model, and logical classifications. The broadly claimed hosting environment is directed to a software operating system including as well a virtual software-based entity within the operating system as noted in specification paragraph [0020]. No structural hardware environment is recited. Indeed, specification paragraph [0026] indicates that the invention, as claimed, can be realized in software.

Independent claim 11 merely recites numerous features related to future actions, such as machine readable, to be performed, for, and when executed, thus indicating no present tense execution within or by any hardware processor or machine. Therefore, this claim appears to be directed to the computer program routine set of instructions set forth in the preamble performing the functional steps in the body of this claim. The claimed storage is generic and only nominally recited and not necessarily structural in nature. No structural storage element is actually recited. Claim 11

therefore includes signal embodiments that are transitory in nature as reflected in specification paragraphs [0020, communications bandwidth and the like] and [0026, distribution of software across several interconnected computer systems]. Thus, this claim covers both nonstatutory subject matter and statutory subject matter since it is broad enough to encompass both transitory and non-transitory storage medium embodiments. Note also the analysis provided by *Subject Matter of Eligibility of Computer Readable Media*, 1351 Off. Gaz. Pat. Office 212 (Feb. 23, 2010).

### CONCLUSION AND DECISION

We have vacated the outstanding rejection over applied prior art of all claims on appeal, claims 1, 2, 4 through 7, 11, 12, and 14 through 17. We have instituted a new ground of rejection within 37 C.F.R. § 41.50(b) of all of these claims. This new rejection of all claims on appeal is based upon 35 U.S.C. § 101 since these claims are directed to non-statutory subject matter.

A new ground of rejection is pursuant to 37 C.F.R. § 41.50(b). Section 41.50(b) provides that, “[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review.”

Section 41.50(b) also provides that the Appellants, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new grounds of rejection to avoid termination of proceedings as to the rejected claims:

- (1) *Reopen prosecution*. Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter

reconsidered by the Examiner, in which event the proceeding will be remanded to the Examiner. . . .

(2) *Request rehearing.* Request that the proceeding be reheard under 37 C.F.R. § 41.52 by the Board upon the same record. . . .

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

VACATED

37 C.F.R. § 41.50(b)

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CAREY, RODRIGUEZ, GREENBERG & PAUL, LLP  
STEVEN M. GREENBERG  
950 PENINSULA CORPORATE CIRCLE  
SUITE 2022  
BOCA RATON, FL 33487